C. REMARKS

Reconsideration and allowance are requested in view of the foregoing amendments and the following remarks.

1. Double Patenting Rejection

Claim54 stands rejected under the judicially created doctrine of double patenting over claim 21 of U.S. Patent No. 6,332,269, which is commonly owned by the Assignee.

Applicants traverse the grounds of rejection advanced by the Examiner. Moreover, upon withdrawal of the art grounds of rejection applied to claim 54, Applicants may file a terminal disclaimer in accordance with 37 C.F.R. §1.321(c) to avoid this rejection, which is based on a nonstatutory type of double patenting.[1]

2. 35 U.S.C. § 102(b) Rejection

Claims 3, 5, 7, 54, and 62-64 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,733,402 to Kawatani ("Kawatani"). Applicants respectfully traverse this rejection.[2]

In the present Office action, the Examiner alleges that "Kawatani discloses a method of placing a component...The claimed 'physically asymmetric marker' of the component is broadly read as the top surface of the component.'[3]

While Applicants continue to disagree with the rejection, independent claims 3, 54, and 62 have been amended in order to expedite prosecution. In particular, Applicants have amended independent claim 3 to recite "said component having leads and an alignment-indicating

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[1] *See* MPEP § 804.02. A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Knohl,* 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and *In re Griswold,* 365 F.2d 834, 150 USPQ 804 (CCPA 1966).

[2] *See* MPEP 2131 *citing* Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.") and Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)("The identical invention must be shown in as complete detail as is contained in the ... claim.").

[3] See Office Action, p.3.

physically asymmetric fiducial marker, said physically asymmetric fiducial marker including a physically asymmetric portion of a bottom surface of the component." Applicants have amended claim 54 to recite "said component having an alignment-indicating physically asymmetric fiducial marker comprising a physically asymmetric portion of a bottom surface of the component." Applicants have amended independent claim 62 to recite "said component having leads and a fiducial marker on a bottom surface thereof, the fiducial marker comprising the alignment-indicating physical shape."

Applicants submit that claims 3, 5, 7, 54, and 62-64 recite combinations of features that are neither taught nor suggested by the prior art, including Kawatani alone or in combination with the other references of record, and that such claims are allowable for at least this reason.

Accordingly, reconsideration and withdrawal of this rejection are requested.

3. 35 U.S.C. § 103(a) Rejection

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kawatani in view of U.S. Patent No. 5,628,110 to Sakaguchi ("Sakaguchi"). Applicants respectfully traverse this rejection.

In the present Office action, the Examiner relies on Sakaguchi to teach "directing, comparing and receiving a pattern of radiation (Fig. 2) for the purpose of disregarding defecting components (see col. 6, lines 13+)."[4] Applicants submit that Sakaguchi is devoid, however, of any teaching or suggestion related to a component having physically asymmetric fiducial marker. According, the teachings of Sakaguchi cannot remedy the deficiencies of Kawatani discussed above with respect to independent claim 3.

The Examiner also is reminded that in order to establish such a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.[5] In addition, there must be a reasonable expectation of success.[6]

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[4] See Office action, p. 4.
[5] See MPEP § 2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
[6] Id.

Moreover, the prior art must teach or suggest all of the claim limitations.[7] Such teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.[8]

Applicants submit that even if Sakaguchi could be combined with Kawatani, which Applicants do not admit, such combination still would fail to disclose all the elements of independent claim 3. In addition, the prior art of record fails to provide any suggestion or motivation to modify or combine reference teachings or of a reasonable expectation of success.

Applicants, also remind the Examiner that the Federal Circuit has explained repeatedly that to support an obvious rejection, the prior art must suggest not merely that modification of the prior art is possible, but rather that the exact modification at issue is desirable.[9]

Applicants submit, therefore, that claim 3 is allowable for at least the reasons set forth above and that claim 9 is allowable by virtue of its dependency, as well as on its own merits.

Accordingly, reconsideration and withdrawal of this rejection are requested.

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[7] Id.
[8] Id.
[9] See, e.g., *In re Laskowski*, 871 F.2d 115 (Fed. Cir. 1989) ("[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."); *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way [that applicant's] apparatus is claimed, there must be some suggestion or motivation in the reference to do so.").

D. CONCLUSION

Applicants submit this application is in condition for allowance and request favorable action in the form of a Notice of Allowance.

Respectfully submitted,

March 30, 2004

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